REMARKS/ARGUMENTS

In the Office Action mailed August 11, 2010, claims 1-11 were rejected. In response, Applicant hereby requests reconsideration of the application in view of the below-provided remarks.

Claim Rejections under 35 U.S.C. 103

Claims 1-11 were rejected based on one or more cited references. The cited reference(s) relied on in these rejections include:

Wood, Jr., (U.S. Pat. No. 6,466,771, hereinafter Wood)

Claims 1-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wood. However, Applicant respectfully submits that these claims are patentable over Wood for the reasons provided below.

Independent Claim 1

Claim 1 is patentable over Wood because the asserted rejection based on Wood is improper. Specifically, the reasoning presented in the Office Action is insufficient to support a *prima facie* case of obviousness for the claim. Claim 1 recites:

> A circuit, this circuit being provided for a communication partner appliance that is designed for contact less communication and as a data carrier, this communication partner appliance being provided for a communication system with at least one further communication partner appliance, in which circuit a first communication mode or a second communication mode can be activated, and which circuit has the means listed below:
>
> activators for activating the first communication mode or the second communication mode, and
>
> reception means for receiving a carrier signal that is transmitted by the at least one further communication partner appliance, and
>
> detectors for detecting the presence of the received carrier signal, these detectors transmitting a carrier signal present signal in the event that the carrier signal is present, and otherwise transmitting a carrier signal not-present signal as a consequence of a missing carrier signal, and

command signal recognition means for recognizing a command signal that can be transmitted with the aid of the carrier signal and for generating and transmitting, within the circuit of the communication partner appliance, a command-end signal that represents the end of the transmitted command signal, and

determination means for determining whether, after the occurrence of the command-end signal, at a given measurement point in time, the carrier signal present signal is present, with which determination means a first activation signal can be transmitted when the carrier signal present signal is present, and otherwise a second activation signal can be transmitted, with which first activation signal the circuit can be brought into the first communication mode with the aid of the activators, and with which second activation signal the circuit can be brought into the second communication mode with the aid of the activators.

(Emphasis added.)

In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)). The analysis must be made explicit. Id. Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Id.

Thus, there are at least three criteria that must be satisfied in order to establish a *prima facie* case of obviousness:

1) The rejection must include a conclusion that the claimed invention would have been obvious.
2) The rejection must include articulated reasoning to support the asserted conclusion of obviousness.
3) The articulated reasoning must be based on some rational underpinning.

In light of the analysis presented below, Applicant submits that the assertions presented in the Office Action do not establish a *prima facie* rejection of the claim because the assertions are not based on a rational underpinning. Rather, the assertions in the Office Actions are mere conclusory statements that are not supported by the actual

teachings of Wood or by other evidence provided by the Examiner. In particular, there are at least two reasons the assertions in the Office Action fail to provide a rational basis for the conclusion of obviousness. First, the assertions in the Office Action are not based on a rational underpinning because the assertions in the Office Action are inconsistent with the actual teachings of Wood. Second the assertions in the Office Action are not based on a rational underpinning because the assertions of alleged inherency and well-known status in the art are improper without supporting evidence.

1. The assertions in the Office Action are inconsistent with the actual teachings of Wood.

Despite the assertions in the Office Action, Wood does not teach at least some of the limitations of the claim. In particular, Wood does not teach transmitting a carrier signal not-present signal as a consequence of a missing carrier signal. Also, Wood does not teach generating and transmitting, within the circuit of the communication partner appliance, a command-end signal. Both of these are discussed in more detail below.

a. Wood does not teach transmitting a carrier signal not-present signal as a consequence of a missing carrier signal.

As a preliminary matter, it should be noted that this issue was previously discussed in detail in response to the prior Office Action dated January 14, 2008. In that Office Action, Examiner Amar Daglawi asserted that Wood purportedly disclosed transmitting a carrier signal not-present signal as a consequence of a missing carrier signal. Office Action, 1/14/08, page 3. In response to those assertions, Applicant provided a detailed response to show that Wood does not disclose the indicated language of the claim. Office Action Response, 4/14/08, pages 7-8. Applicant's prior response resulted in withdrawal of the corresponding rejection. Office Action, 6/30/08, page 2. It should also be noted that the Examiner similarly found Applicant's subsequent remarks persuasive to traverse the rejections further based on the combined teachings of Wood and MacLellan. Advisory Action, 10/3/08, page 1, item 11.

Thus, it appears that the current Examiner may have inadvertently overlooked some of the history of this case. Accordingly, Applicant provides a summary below of

the remarks that were previously provided to show that Wood does not teach transmitting a carrier signal not-present signal as a consequence of a missing carrier signal. Alternatively, if this iteration of the same assertion is somehow based on new insight by the current Examiner, Applicant respectfully requests that the current Examiner provide additional explanation (in addition to merely listing column and line numbers) to explain how the repetition of these assertions might be justified in light of the prior successful traversal of this point.

To review the previous arguments presented by Applicant, it may be useful to refer to the description provided in the specification for a contextual understanding of the carrier signal present signal and the carrier signal not-present signal, as recited in claim. While these details of the specification do not limit the scope of the claims, they may provide the Examiner with a better understanding of the limitations recited in the claim relative to embodiments described in the specification. Within a communication partner appliance operating as a data carrier 2 (referred to Fig. 2), the detectors 32 are designed to detect the presence of a carrier signal received from another communication partner appliance operating as a reader station 3. If a carrier signal is present (i.e., the carrier signal is received from the reader station 3), the detectors 32 emit or transmit a carrier signal present signal PS within the data carrier 2 to the determination means 27. Otherwise, if the carrier signal is not present (i.e., the carrier signal is not received from the reader station 3), then the detectors 32 emit or transmit a carrier signal non-present signal (NPS) within the data carrier 2 to the determination means 27. Specification, page 13, lines 27-31. Hence, these signals, PS and NPS, indicate whether or not the carrier signal is received from the reader station 3. As a matter of clarification, claim 1 is presently amended to clarify that the carrier signal non-present signal NPS is generated as a consequence of a missing carrier signal.

In contrast, Wood does not teach transmitting a carrier signal not-present signal as a consequence of a missing carrier signal. Wood merely describes a transmitter 32 which is switchable between operating in a modulated backscatter transmitter mode and an active mode based on a radio frequency command received from an interrogator. In other words, Wood describes the interrogator sending separate command signals to switch between the backscatter transmitter mode and the active mode. Nevertheless, Wood does

not describe switching modes in response to the absence of a signal, or as a consequence of a missing signal, because the mode switching of Wood relies on the presence of a specific command signal to switch from the backscatter transmitter mode to the active mode, or vice versa. Therefore, even if Wood were to describe generating a carrier signal present signal and a carrier signal not-present signal, in response to the separate command signals from the interrogator, Wood nevertheless does not teach transmitting a carrier signal not-present signal as a consequence of a missing carrier signal, as recited in the claim.

b. Wood does not teach generating and transmitting, within the circuit of the communication partner appliance, a command-end signal.

As with the remarks provided in sub-section (a), it should be noted that this issue was also previously discussed in detail in response to the prior Office Action dated January 14, 2008. In that Office Action, Examiner Amar Daglawi asserted that Wood purportedly disclosed generating and transmitting, within the circuit of the communication partner appliance, a command-end signal. Office Action, 1/14/08, page 3. In response to those assertions, Applicant provided a detailed response to show that Wood does not disclose the indicated language of the claim. Office Action Response, 4/14/08, page 8. Applicant's prior response resulted in withdrawal of the corresponding rejection. Office Action, 6/30/08, page 2. It should also be noted that the Examiner similarly found Applicant's subsequent remarks persuasive to traverse the rejections further based on the combined teachings of Wood and MacLellan. Advisory Action, 10/3/08, page 1, item 11.

Thus, it appears that the current Examiner may have inadvertently overlooked some of the history of this case. Accordingly, Applicant provides a summary below of the remarks that were previously provided to show that Wood does not teach generating and transmitting, within the circuit of the communication partner appliance, a command-end signal. Alternatively, if this iteration of the same assertion is somehow based on new insight by the current Examiner, Applicant respectfully requests that the current Examiner provide additional explanation (in addition to merely listing column and line

numbers) to explain how the repetition of these assertions might be justified in light of the prior successful traversal of this point.

In contrast to the indicated language of the claim, Wood does not recite generating and transmitting a command-end signal within the circuit of a communication partner appliance. Although the Office Action appears to suggest that the unmodulated 2.44 GHz signal described in Wood might be a command-end signal, Applicant submits that the 2.44 GHz signal of Wood does not anticipate the clarified language of the claim because the 2.44 GHz signal of Wood is generated by the interrogator and transmitted out of the interrogator. The 2.44 GHz signal of Wood is not generated and transmitted within the interrogator or, alternatively, within the corresponding radio frequency data communication device. Rather, the 2.44 GHz signal is transmitted from the interrogator to the radio frequency data communication device.

Moreover, it should be noted that the system of Wood describes a single device—the interrogator—which functions to transmit both the carrier signal and the 2.44 GHz signal. In contrast, within the context of the claim, the carrier signal and the carrier-end signal are generated by different communication partner appliances. In particular, a first communication partner appliance receives the carrier signal from second communication partner appliance (i.e., the second communication partner appliance generates the carrier signal), and then the first communication partner appliance generates and transmits the command-end signal within the first communication partner appliance. Therefore, the system of Wood describes a different type of system because Wood merely describes a single device which generates both the carrier signal and the 2.44 GHz signal, rather than two separate functional units which independently generate the carrier signal and the command-end signal.

2. The assertions in the Office Action of alleged inherency and well-known status in the art are improper.

In addition to the failure of Woods to support the assertions provided in the Office Action, the assertions in the Office Action also lack a rational underpinning because the assertions in the Office Action of inherent and well-known teachings are not properly

supported by evidence. Rather, these assertions merely amount to conclusory statements that are lacking in support. As one example, the reasoning in the Office Action states:

> The Examiner firmly submits that it is inherent and well known to one of ordinary skill in the art for transponder 16 to internally within the circuit "transmit a carrier signal present signal in the event that the carrier signal is present, and otherwise transmit a carrier signal not present signal as a consequence of a missing carrier signal" when internally within the circuit of transponder 16 switching between active and passive modes.
> Office Action, 8/11/10, page 7 (emphasis added).

In other words, the Examiner asserts that the transponder of Wood necessarily transmits a carrier signal not-present signal as a consequence of a missing carrier signal simply because the transponder switches between two modes. However, this assertion does not provide any type of explanation or evidence in support of the asserted inherency or well-known teachings.

In fact, this assertion of inherency is insufficient to support the rejection of claim 12 at least because the assertion of inherency is not properly supported by rationale or evidence, as required by the MPEP. The MPEP states that the Examiner must provide rationale or evidence in order to show inherency. MPEP 2112(IV). More specifically, in relying on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the assertion that an allegedly inherent characteristic necessarily flows from the teachings of the cited reference. Id. Moreover, the MPEP states that the possible occurrence of a result or characteristic is not sufficient to establish inherency of the asserted result or characteristic. Id.

Here, the Office Action merely restates some of the disclosure of Wood related to switching between communications modes. However, in light of the lack of disclosure by Wood, the reasoning in the Office Action simply concludes that it is allegedly inherent in the disclosure of Wood to transmit a carrier signal not-present signal as a consequence of a missing carrier signal. Moreover, there is no explanation of any type of relationship between the functionality in Wood of switching communication modes and the possibility of transmitting the specific type of signal recited in the claim under the specific conditions recited in the claim. Thus, the conclusion of inherency asserted in the Office Action is not supported by any rationale or evidence.

Although the Office Action includes a conclusion that the indicated language of the claim is allegedly inherent or well-known, the Office Action does not include any reasoning that would provide a rationale to explain why transmitting a carrier signal not-present signal as a consequence of a missing carrier signal might have been inherent based on the description of switching communication modes. Additionally, the reasoning in the Office Action does not describe any facts or technical reasoning that would support the assertion of inherency. Moreover, the Office Action does not provide any extrinsic evidence to remedy this lack of rationale. In other words, the assertions in the Office Action merely amount to unsupported conclusion of inherency, without providing any rationale or evidence to show how the Examiner might have arrived at the asserted conclusion of inherency. This failure to properly support the assertions of inherency is insufficient to provide a rational underpinning for the conclusion of obviousness.

For the reasons presented above, the asserted conclusions and articulated reasoning presented in support of the rejection based on Wood is not supported by a rational underpinning. Consequently, the Office Action does not establish a *prima facie* case of obviousness because the assertions in the Office Action do not provide articulated reasoning with a rational underpinning. Accordingly, Applicants respectfully assert the rejection of claim 1 is improper because the Office Action does not establish a *prima facie* case of obviousness.

CONCLUSION

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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Date: November 12, 2010

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